

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trad mark Offic**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/973, 363 02/04/98 GRIFFITHS

R 263PPNTIR117

HM22/0422

EXAMINER

WENDEROTH LIND & PONACK  
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WASHINGTON DC 20005SCHNITZER, R  
ART UNIT PAPER NUMBER

12

1632

DATE MAILED:

04/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/973,363</b>	Applicant(s) <b>Griffiths</b>
	Examiner <b>Richard Schnizer</b>	Group Art Unit <b>1632</b>

Responsive to communication(s) filed on \_\_\_\_\_.  
 This action is **FINAL**.  
 Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-33 are subject to restriction or election requirement.

**Application Papers**

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

Notice of References Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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**DETAILED ACTION**

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16, drawn to DNA molecules and a first method of using.

Group II, claim(s) 17 and 18, drawn to a method for controlling the sex of birds using DNA.

Group III, claim(s)19-22 and 27, drawn to proteins.

Group IV, claim(s)23 and 24, drawn to a method for controlling the sex of birds using proteins.

Group V, claim(s)25 and 26, drawn to antibodies.

Group VI, claim(s)28-31, drawn to transgenic birds.

Group VII, claim(s)32 and 33, drawn to a method of population control using a transgenic bird.

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The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of group I is a nucleic acid molecule or molecules with defined sequence characteristics, and a method of these molecules to determine the sex of a non-ratite bird. The DNA of group I is materially different than the proteins of group III, the antibodies of group V, and the transgenic birds of group VI. The DNA of group I can be used for purposes other than the methods of groups II, IV or VII, *e.g.* hybridization assays.

The technical feature of group II is a method for controlling the sex of birds using DNA molecules. This method does not directly require the use of proteins, as does the method of group IV. The method of group II can be used in the method of group VII, however it may also be used independently of that method, because it does not require transformation of germline cells and need not result in a heritable genomic modification. The method of group II does not require the proteins of group III, nor the antibodies of group V. The method of group II need not result in the transgenic bird of group VI because transformation of germline cells is not required.

The technical feature of group III is a CHD-protein or fragment thereof and its use in determining the sex of a non-ratite bird. This is not a method of controlling the sex of birds, as in group IV, nor is it a method of population control, as in group VII. The proteins of group III are not the antibodies of group V, nor are they the transgenic birds of group VI.



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The technical feature of group IV is a process of controlling the sex of birds using proteins. This method does not involve or require transgenic birds as do the inventions of groups VI and VII, neither does it involve the antibodies of group V.

The technical feature of group V is an antibody which recognizes an epitope of a CHD-protein. Such antibodies are not required for the transgenic bird of group VI, nor the method of population control of group VII.

The technical feature of group VI is a transgenic non-ratite bird which may be used in the invention of group VII, but which may also be used for other purposes not required for the invention of group VII. For example, the transgenic birds of group VI may be used as food.

A telephone call was made to Warren Cheek on 4/16/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Schnizer whose telephone number is (703) 306-5441.

  
JAMES MARTINELL, PH.D.  
SENIOR LEVEL EXAMINER  
GROUP 1800 1632

RAS

April 20, 1999